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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,032	08/26/2003	William B.S. Pressly SR.	MSF-9-CON	2419

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EXAMINER

JACYNA, J CASIMER

ART UNIT PAPER NUMBER

3751

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/648,032	Applicant(s) PRESSLY ET AL.	
	Examiner J. Casimer Jacyna	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-31 and 34-36 is/are pending in the application.  
4a) Of the above claim(s) 31 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 29 and 30 is/are objected to.
- 8) ☒ Claim(s) 23-31 and 34-36 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 31, drawn to a method for retracting a needle, classified in class 604, subclass 164.08.
  - II. Claims 23-30, 34 and 35, drawn to a method for inserting a needle and catheter into a body, classified in class 604, subclass 189.
  - III. Claim 36, drawn to a method for restricting blood flow, classified in class 604, subclass 164.01.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as usage in retracting a needle from filling a lab vial and not connected to a body. Invention II has separate utility such as usage without any restriction of blood flow. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. Ben Mullinex on 6/16/2004 a provisional election was made with traverse to prosecute the invention of group II, claims 23-30, 34 and 35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31 and 36 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23, 24, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Haining. Haining discloses a method for using a catheter including inserting a needle tip and catheter on col. 3, lines 24-37, simultaneously depressing release tabs 63 and 64 which are both actuated as part of element 60, then partially retracting the tip into the catheter as disclosed on col.3, lines 27-42, and finally

retracting the needle into a hollow body as is the hub on col. 3, lines 42-46 and as shown in figure 4.

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haining in view of Clark et al. and DeMichele et al. Haining discloses a method for inserting a catheter substantially as claimed but does not disclose a message on the catheter.

However, Clark and DeMichele teach other methods for using catheters having messages on the catheter for the purpose of relaying information to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the catheter of Haining with a message as, for example, taught by Clark and DeMichele in order to relay information to the user.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haining in view of Lituchy. Haining discloses a method for inserting a catheter substantially as claimed but does not disclose a magnifying means. However, Lituchy teaches another method for using a catheter having a magnifying means on the catheter for the purpose of more easily identifying blood flash back. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the catheter of Haining with a magnifying means as, for example, taught by Lituchy in order to more easily identify blood flash back.

10. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haining in view of Botich et al. Haining discloses a method for inserting a catheter substantially as claimed but does not disclose an audible click. However, Botich teaches another method for using a catheter having an audible click as disclosed on col. 10, line 57, to

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col. 11, line 12, for the purpose of ensuring the user that the needle is fully retracted.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the catheter of Haining with an audible click as, for example, taught by Botich in order to ensure the user that the needle is fully retracted.

11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haining in view of Osterlind. Haining discloses a method for inserting a catheter substantially as claimed but does not disclose the use of a boot. However, Osterlind teaches another method for using a catheter having a boot 30, 32, for the purpose of stopping the flash back of blood. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the catheter of Haining with a boot as, for example, taught by Osterlind in order to stop the flash back of blood.

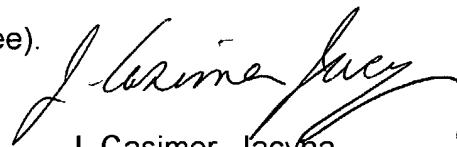
12. Claims 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Casimer Jacyna whose telephone number is 703-308-1508. The examiner can normally be reached on Tue. thru Thu. 9AM-8PM, Fri. 7AM-1PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Casimer Jacyna  
Primary Examiner  
Art Unit 3751

JCJ